Samuel C. Straight (7638)
**RAY QUINNEY & NEBEKER P.C.**
36 South State Street, Suite 1400
Salt Lake City, Utah 84111
Telephone: (801) 532-1500
Facsimile: (801) 532-7543
sstraight@rqn.com

George L. Murphy Jr. (*pro hac vice* admission application forthcoming)
Email: *gmurphy@kilpatricktownsend.com*
Richard W. Goldstucker (*pro hac vice* admission application forthcoming)
Email: *rgoldstucker@kilpatricktownsend.com*
KILPATRICK TOWNSEND & STOCKTON LLP
1100 Peachtree Street NE, Suite 2800
Atlanta, GA 30309
Telephone: (404) 815-6500

Attorneys for Plaintiffs Oldcastle, Inc., Oldcastle Materials, Inc., and Staker & Parson Companies

**IN THE UNITED STATES DISTRICT COURT**

**FOR THE DISTRICT OF UTAH CENTRAL DIVISION**

| | |
|---|---|
| OLDCASTLE, INC.;<br>OLDCASTLE MATERIALS, INC.; AND<br>STAKER & PARSON COMPANIES,<br><br>Plaintiffs,<br><br>v.<br><br>TUKWADT SCHWOOMP, LLC,<br><br>Defendant. | **COMPLAINT FOR DECLARATORY JUDGMENT**<br><br>**JURY TRIAL DEMANDED**<br><br>Case No. ______________________<br><br>The Honorable _________________ |

Plaintiffs Oldcastle, Inc. ("Oldcastle"), Oldcastle Materials, Inc. ("Oldcastle Materials"), and Staker & Parson Companies ("SPC") (collectively "Plaintiffs") file this Complaint for Declaratory Judgment ("Complaint") against Defendant Tukwadt Schwoomp, LLC ("TSL" or

"Defendant"). Plaintiffs seek declaratory relief pursuant to 28 U.S.C. §§ 2201 and 2202, declaring that Plaintiffs do not infringe United States Patent No. RE39,289 (the "'289 Patent").

**PARTIES**

1. Plaintiff Oldcastle is a corporation organized and existing under the laws of Delaware with its principal place of business at 900 Ashford Parkway, Suite 600, Atlanta, Georgia 30338. Oldcastle is a holding company that indirectly owns other companies that manufacture building products and materials.

2. Plaintiff Oldcastle Materials is a corporation organized and existing under the laws of Delaware with its principal place of business at 900 Ashford Parkway, Suite 600, Atlanta, Georgia 30338. Oldcastle Materials is a holding company subsidiary of Oldcastle, and directly or indirectly owns other companies that, among other things, produce and supply asphalt.

3. Plaintiff Staker & Parson Companies is a corporation organized and existing under the laws of Utah, with its principle place of business at 2350 South 1900 West, Ste. 100 Ogden, Utah 84401. SPC is a subsidiary of Oldcastle and, among other things, produces and supplies asphalt in Utah.

4. Upon information and belief, Defendant Tukwadt Schwoomp, LLC, is a Utah corporation with a principal place of business at 12997 West Highway 87, P.O. Box 186, Altamont, Utah 84001 and may be served through its registered agent at the aforementioned address.

## JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction over this matter pursuant to 28 U.S.C. § 1338(a), because this is a case arising under the patent laws of the United States (35 U.S.C. § 1, *et seq*., and particularly 35 U.S.C. § 271) and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202 and also pursuant to 28 U.S.C. § 1331, because this matter involves federal questions under the Patent Act.

6. This Court has personal jurisdiction over TSL because it resides within this judicial district and because it has engaged in enforcement actions and related meetings in this judicial district concerning the ‘289 Patent. In addition, TSL directed its assertions of infringement of the ’289 Patent to Plaintiffs in the State of Utah and the effect of TSL’s actions are felt by Plaintiffs in Utah. Thus, this Court has both general and specific personal jurisdiction over TSL.

7. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 and § 1400(b) because TSL resides in this judicial district within the meaning of such provisions and because it has transacted business and a substantial part of the events giving rise to the claims occurred in this district.

## FACTUAL BACKGROUND

8. Plaintiffs incorporate by reference each and every allegation in the preceding paragraphs.

9. Oldcastle is a holding company that indirectly owns other companies that manufacture building products and materials. Oldcastle Materials is a holding company subsidiary of Oldcastle, and directly or indirectly owns other companies that, among other

things, produce and supply asphalt. SPC is a subsidiary of Oldcastle and, among other things, produces and supplies asphalt in Utah.

10. Upon information and belief, TSL was formed on or about August 12, 2013. Upon information and belief, TSL is solely a licensing entity formed for the specific purpose to acquire, own, hold, or assign intangible personal property and any lawful business. As part of its business, TSL seeks to pursue alleged claims of infringement relating to the ’289 Patent. Upon information and belief, TSL does not make, use or sell any products covered by the ’289 Patent. Instead, upon information and belief, TSL seeks to acquire patent rights and monetize them either through licensing or enforcement or both.

11. TSL has asserted that it is the owner of the ’289 Patent. Upon information and belief, the ’289 Patent was filed on February 9, 1999 and issued as U.S. Patent No. 6,045,068 on April 4, 2000. It was subsequently reissued as the ’289 Patent on September 19, 2006.

12. On October 27, 2016, counsel for TSL wrote a letter to employees of SPC and Oldcastle Materials entitled “U.S. Patent No. RE39,289. A true and correct copy of the letter is attached as Exhibit A. The letter stated that TSL sought to enforce the ’289 Patent and that it would like to reengage SPC and Oldcastle Materials about acquiring or licensing the ’289 Patent. The letter stated that “[a]s time is of the essence, this meeting…must include meaningful progress towards SPC/BM acquiring or licensing the ’289 Patent and resolving the referenced infringements.”

13. The letter included a list of purported “infringements” by SPC and Oldcastle Materials. A true and correct copy of the list, entitled “Projects / Infringements” is attached as Exhibit B.

14. On December 13, 2016, counsel for TSL provided a letter to an employee of Oldcastle, entitled "Preservation & Legal Hold Notice, U.S. Patent No. RE39,289 ('289 Patent), Tukwadt Schwoomp, LLC (TSL)." A true and correct copy of the letter is attached as Exhibit C. In the letter, counsel for TSL referenced the previous letter and noted that the issues "may require litigation" and instructed Plaintiffs as to their "affirmative and continuing legal duty under both federal and Utah law to identify, locate, maintain and preserve…any and all Potentially Relevant Documents, Information and other Evidence…that may pertain to or relate to the '289 Patent or its potential infringement." Counsel for TSL listed the "Potentially Relevant Documents" in the legal hold notice by type.

15. TSL's infringement allegations threaten actual and imminent injury to Plaintiffs that can be redressed by judicial relief and that injury is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. Such injury includes, among other things, uncertainty in the marketplace as to whether Plaintiffs' paving products are free from infringement claims based on the '289 Patent. Absent a declaration of non-infringement, TSL's continued wrongful assertions of infringement will cause Plaintiffs irreparable injury and damage.

16. Under the circumstances, Plaintiffs have a reasonable apprehension of imminent suit by TSL.

17. Consequently, TSL and Plaintiffs have adverse legal interests. Moreover, there is a definite and concrete dispute between TSL and Plaintiffs that is real and substantial.

**COUNT I**
**Declaratory Judgment of Non-Infringement of the ’289 Patent**

18. Plaintiffs incorporate the foregoing paragraphs by reference as though set forth fully herein.

19. No claim of the ’289 Patent has been or is infringed, either directly or indirectly, literally or under the doctrine of equivalents, by Plaintiffs.

20. Plaintiffs have never manufactured, used, imported, offered for sale and/or sold in the United States any products or services which infringe the ’289 Patent. By way of example, Plaintiffs’ paving products do not include a composition comprising by weight “from about 20 to about 80 percent tar sand; from about 80 to about 20 percent aggregate; and from about 1 to less than about 5 percent liquid asphalt cement” as required by the claims of the ’289 Patent.

21. As a result of the acts described in the foregoing paragraphs, there exists a substantial controversy of sufficient immediacy and reality between TSL and Plaintiffs to warrant the issuance of a declaratory judgment that Plaintiffs have not infringed, and do not infringe, directly or indirectly, literally or under the doctrine of equivalents, any valid claim of the ’289 Patent.

**REQUEST FOR RELIEF**

WHEREFORE, Plaintiffs respectfully request that judgment be entered in its favor and against Defendant as follows:

a. A declaration that Plaintiffs have not infringed and are not infringing, either directly or indirectly, any claim of the ’289 Patent;

b. An order that TSL and each of its officers, employees, agents, attorneys, and any persons in active concert or participation with them are restrained and enjoined from further prosecuting or instituting any action against Plaintiffs claiming that the ’289 Patent is infringed or from representing that Plaintiffs products infringe the ’289 Patent;

c. To the extent that Plaintiffs are the prevailing party and it is determined that this is an exceptional case, a declaration that this case is exceptional and awarding Plaintiffs their expenses, disbursements, and reasonable attorney’s fees under 35 U.S.C. § 285 and all other applicable statutes, rules, and common law;

d. An award to Plaintiffs of their costs; and

e. Such other relief as this Court or a jury may deem proper and just under the circumstances.

**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiffs demand a trial by jury on all issues so triable.

DATED: December 15, 2016

RAY QUINNEY & NEBEKER P.C.

*/s/ Samuel C. Straight*
Samuel C. Straight

*Attorney for Plaintiffs Oldcastle, Inc., Oldcastle Materials, Inc., and Staker & Parson Companies*

1397081